REMARKS

Applicants submit an Excess Claim Fee Payment Letter for one additional independent claim.

Claims 1, 6-7, 10, 15-17 and 19-30 are all the claims presently pending in the application. The specification and claims 1, 6-7, 10, 15-16, and 21 are amended to more clearly define the invention, claims 4-5 and 13-14 are canceled, and claims 22-30 are added. Claims 1, 10, 21, and 25 are independent.

Applicants appreciate the courtesies extended to Applicant's representative during the telephone conference with the Examiner on April 21, 2004. During the telephone conference, the Examiner explained the new matter and enablement rejections that are present in the March 8, 2004 Office Action. These rejections are addressed below.

These amendments are made only to more particularly point out the invention for the Examiner and not for narrowing the scope of the claims or for any reason related to a statutory requirement for patentability.

Applicants also note that, notwithstanding any claim amendments herein or later during prosecution, Applicants' intent is to encompass equivalents of all claim elements.

Claims 1, 4-8, 10, 13-17 and 19-21 stand rejected under 35 U.S.C. § 102(a) as being anticipated by the Kanari et al. reference (U.S. Patent No. 6,234,697).

This rejection is respectfully traversed in the following discussion

I. THE CLAIMED INVENTION

A first exemplary embodiment of the claimed invention, as recite by, for example, independent claim 1, is directed to a mechanical pencil that includes a barrel, a lead feeding

mechanism disposed in the barrel to tighten and feed a lead, and a single-piece lead holder disposed between the lead feeding mechanism and a tip end of said barrel. The single-piece lead holder having a through hole through which the lead penetrates. The single-piece lead holding including holding portions, for holding the lead, a contact portion for contacting an inner peripheral surface of the barrel, and a body. The holding portions including a first holding portion at a front portion of the lead holder and a second holding portion at a rear portion of the lead holder, so that when a length of the lead becomes shorter than a distance between the lead feeding mechanism and the tip end of said barrel, the first holding portion holds the short lead and the second holding portion holds a next lead tightened by the lead feeding mechanism. The contact portion includes an outside cylinder provided concentrically on an outside of the body. The outside cylinder includes a rib projecting in an outside diameter direction to come into contact with the inner peripheral surface of the barrel. A slit is formed in a portion of the outside cylinder in which the rib of the outside cylinder is absent so that the rib is elastically displaceable radially outwardly into contact with the inner peripheral surface of the barrel.

In this manner, the single-piece lead holder includes a double-tube type of construction with the outside cylinder provided concentrically on an outside of the body. This construction is very effective for contacting the inner peripheral surface of the barrel (page 6, line 23 - page 7, line 1).

A second exemplary embodiment of the claimed invention, as recited by, for example, new independent claim 25, is directed to a writing instrument that includes a barrel, a writing medium feeding mechanism disposed in the barrel to be adapted to tighten and feed a writing medium, and a single-piece writing medium holder disposed between the writing medium

feeding mechanism and a tip end of the barrel. The writing medium holder being axially slidable within said barrel and having a through hole through which the writing medium penetrates. The writing medium holder includes holding portions for holding the writing medium, and a contact portion for contacting an inner peripheral surface of the barrel. The holding portions include a first holding portion at a front portion of the writing medium holder and a second holding portion at a rear portion of the writing medium holder so that when a length of the writing medium becomes shorter than a distance between the writing medium and the tip end of the barrel. The first holding portion holds the short writing medium and the second holding portion holds a next writing medium tightened by the writing medium feeding mechanism. The contact portion includes an outer peripheral surface that is elastically displaceable radially outwardly into contact with the inner peripheral face of the barrel. The contact portion maintains frictional contact with the inner peripheral surface of the barrel throughout the axially slidable extent.

In this manner, the single-piece lead holder always maintains frictional contact with the inner peripheral surface of the barrel and therefore, always fixes the lead (or two leads) relative to the barrel.

Further, the single-piece lead holder simplifies construction and reduces cost by reducing the number of parts.

II. THE 35 U.S.C. § 112, FIRST PARAGRAPH REJECTIONS

The Office Action alleges that claims 1, 4-8, 10, 13-17, and 19-20 are not enabled by the specification. In particular, the Office Action points out that the specification discloses that "the rib 50g of the outside cylinder 50c forms a contact portion that comes into contact

with the inner peripheral face of the tip end member 14" (emphasis added) at page 6, line 22 and alleges that the specification does not reasonably provide enablement for "said contact portion(s) comprise(s) an outer peripheral surface that is elastically displaceable radially outwardly into contact with said inner peripheral face of the barrel" (emphasis added).

During the telephone conference on April 21, 2004, the Examiner alleged that the barrel does not correspond to the tip end member.

Applicants respectfully traverse this rejection.

Contrary to the Examiner's allegation, the specification enables those of ordinary skill in the art. For example, at page 5, lines 3-9, the specification makes it clear that "[t]he barrel 10 includes a front barrel 12, a tip end member 14 screwed into the front barrel 12, and a rear barrel (not shown). . . . The front barrel 12, the tip end member 14, and the rear barrel can be formed integrally (e.g., a unitary construction), or can be formed of more parts than in this embodiment."

Therefore, contrary to the Office Action's allegation, the specification clearly explains that the tip end member merely forms part of the barrel and, therefore, clearly enables one of ordinary skill in the art to provide "an outer peripheral surface that is elastically displaceable radially outwardly into contact with said inner peripheral face of the barrel" when the specification explains that the "[t]he barrel 10 includes . . . a tip end member 14" and later discloses an exemplary embodiment where the "contact portion that comes into contact with the inner peripheral face of the tip end member 14" at page 6, line 22.

Applicants respectfully request withdrawal of this rejection of claims 1, 4-8, 10, 13-17, and 19-20.

Regarding claims 4-5 and 13-14, the Office Action alleges that the specification is not

enabling for a "contact portion comprises an outside cylinder." This Amendment amends the specification at, page 6, line 22 through page 7, line 2 to clarify that the contact portion may be the rib 50g of the outside cylinder 50c. In other words, the contact portion in the exemplary embodiment that is described in the specification is (i.e. comprises) the rib 50g of the outside cylinder 50c.

Applicants respectfully request withdrawal of this rejection of claims 4-5 and 13-14 (as now incorporated into independent claims 1 and 10, respectively).

Regarding claim 21, the Office Action alleges that the specification does not reasonably provide enablement for a single-piece writing medium holder that comprises an outer peripheral surface that is elastically displaceable radially outwards into contact with an inner peripheral of the barrel because the specification at the paragraph that begins on page 6, line 22 explains that the contact portion comes into contact with the inner peripheral face of the tip end member 14.

Applicants respectfully traverse this rejection.

As explained above, the specification clearly explains that the tip end member merely forms part of the barrel and, therefore, clearly enables one of ordinary skill in the art to provide "an outer peripheral surface that is elastically displaceable radially outwardly into contact with said inner peripheral face of the barrel" when the specification explains that the "[t]he barrel 10 includes . . . a tip end member 14" and later discloses an exemplary embodiment where the "contact portion that comes into contact with the inner peripheral face of the tip end member 14."

Applicants respectfully request withdrawal of this rejection of claim 21.

III. THE 35 U.S.C. § 112, SECOND PARAGRAPH REJECTION

The Examiner alleges that claims 10, 13-17, and 19-20 are indefinite. While Applicants submit that such would be clear to one of ordinary skill in the art taking the present Application as a whole, to speed prosecution claim 10 has been amended in accordance with Examiner Prunner's very helpful suggestion.

In view of the foregoing, the Examiner is respectfully requested to withdraw this rejection.

IV. THE PRIOR ART REJECTION

Regarding the rejection of claims 1, 4-8, 10, 13-17 and 19-21, the Examiner alleges that the Kanari et al. reference teaches the claimed invention. Applicants submit, however, that there are elements of the claimed invention which are neither taught nor suggested by the Kanari et al. reference.

The Kanari et al. reference does not teach or suggest the features of the present invention including a contact portion that is elastically displaceable radially outwardly and an outer cylindrical cylinder provided concentrically on an outside of the body.

As explained above, this type of construction is important for the single-piece lead holder to elastically contact the inner peripheral surface of the barrel.

Further, the Kanari et al. reference does not teach or suggest a slit formed in a portion of the outside cylinder in which the rib of the outside cylinder is absent.

Rather, while Figure 8(A) of the Kanari et al. reference appears to disclose a slit 78, that slit is not formed in a portion on an outside cylinder. Indeed, the slit 78 appears to be formed at an inner cylinder portion of the lead holder.

The slit 78 of the Kanari et al. reference is provided to insert the front end pipe (60) into the mouthpiece 32. In stark contrast, the aim of the slit of the present invention is to obtain a stable holding force.

Regarding new independent claim 25, the Kanari et al. reference does not teach or suggest the features of the present invention including a single-piece lead holder that has a contact portion that maintains frictional contact with the inner peripheral surface of the barrel throughout the axially slidable extent of the lead holder within the barrel. As explained above, this feature is important for always maintaining frictional contact with the inner peripheral surface of the barrel and therefore, always fixing the lead (or two leads) relative to the barrel.

Indeed, The Kanari et al. reference teaches away from the present invention. In particular, the Kanari et al. reference discloses a releasing portion 48 of the slider 44 that allows the frictional resistance of the slider-resisting member 46 to be reduced or completely overcome. Thus, when the lead is projected from the tip end of the barrel, the holder (36, 44) does not have any (or has very little) frictional contact with the inner peripheral face of the barrel, and can be moved with the lead from the state shown in Fig. 2 to the state shown in Fig. 4.

In other words, the holder (36, 44) does not fix the lead relative to the barrel during writing. Only when the lead is retracted into the barrel as shown in Fig. 5 of Kanari, et al. does the holder (36, 44) come into contact with the inner peripheral face of the barrel via the slider-resisting member 46 to keep the lead inside of the barrel.

In stark contrast, the present invention includes a contact portion that maintains frictional contact with the inner peripheral face of the barrel throughout the axially slidable

extent of the lead holder within the barrel. In this manner, the lead holder always maintains frictional contact with the inner peripheral face of the barrel and therefore, always fixes the lead (or two leads) (writing medium in the case of claim 21) relative to the barrel.

Therefore, the Kanari et al. reference does not teach or suggest each and every element of the claimed invention. Therefore, the Examiner is respectfully requested to withdraw this rejection of claims 1, 4-8, 10, 13-17 and 19-21.

V. FORMAL MATTERS AND CONCLUSION

The Office Action objects to the specification. In particular, the Examiner alleges that the Amendment filed on October 15, 2003 introduces new matter into the disclosure. During the telephone conference on April 21, 2004, the Examiner alleged that the barrel does not correspond to the tip end member. This Amendment amends the specification to clarify that the tip end member is part of the barrel.

Further, the Office Action objects to the specification as failing to provide proper antecedent basis for the claimed terminology. This Amendment amends the specification to provide the antecedent basis for the claimed terminology.

Applicants respectfully request withdrawal of these rejections.

In view of the foregoing amendments and remarks, Applicant respectfully submits that claims 1, 6-7, 10, 15-17 and 19-30, all the claims presently pending in the Application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the Application to be other than in condition for allowance,

the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: 6/8/04

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